UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,494	11/19/2003	Kazuo Okada	245550US2	5961

22850 7590 07/17/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/17/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/715,494	OKADA, KAZUO	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 4/17/07, claims 1 and 5 have been amended and claim 4 has been canceled without prejudice. Furthermore, claims 9-11 have been newly added. Claims 1-3 and 5-11 are pending in the current application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-7 and claims 1-10 of copending Application No. 10/697,238 and 10/697,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards a gaming machine that comprises a variable display device that displays designs or symbols. Additionally, they include a front electric display which consist from a group of at

least a liquid crystal display panel or series of light emitting diodes. This display uses a light guiding plate to create an illuminating effect for the display device so that a gaming machine can produce several different array of symbols and designs that compliment the basic reel display device commonly found in game machines. The two sets of claims have simply been rearranged so that they are claimed in different orders and are directed towards the same device except one uses a light emitting diode and the other a liquid crystal display. However, these are different forms of lighting display devices and perform the same function therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either type of lighting device to perform the same functions as described in the claims. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. (EP 1,260,928 A2) and further in view of Mastera et al. (US 6,315,666 B1).

Regarding claims 1, 5 and 11, Loose et al. disclose a gaming machine comprising: a display unit configured to variably and statically display a plurality of symbols (*see mechanical reels [12(a-c)] of Fig. 1 and the related description thereof*); an electrical display provided in front of the display unit and configured to display a pay table in which a winning combination is associated with a predetermined prize to be awarded when the winning combination is formed and a controller configured to (*see Fig. 2(a-b and 5 and the respective related descriptions thereof)*, when the winning combination is formed depending on a combination of the symbols statically displayed on the display unit, award a prize associated with the formed winning combination based on the pay table (*see microcontroller [30] of Fig. 1 and the related description thereof*). However, Loose does teach the implementation of an electrical display above the mechanical reels as a secondary display but does not teach the display of a paytable on the secondary display *(see display [40] of Fig. 1 and the related description thereof)*.

However in an analogous gaming patent, Mastera et al. teaches the implementation of a secondary display provided on the top of the variable display that displays the pay table (*see secondary display [219] of Fig. 2 and the related description thereof*). Mastera teaches that one would be motivated to incorporate such a feature to allow the player to simultaneously examine the pay table while viewing the primary game (*see col. 17: ln 20-35*). Additionally, Mastera teaches that the display is adaptable to display the pay table of various primary games to allow users to more easily play the various games of slots, keno, or video poker, on a multi-game machine (*see col. 17: ln 20-35*). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the secondary display features of

Mastera with that of Loose to incorporate a secondary display that was able to display various paytables dependent on the primary game being played by the user.

Furthermore, Mastera et al. teaches of a gaming machine wherein the controller switches from displaying the pay table on the electrical display to a second pay table different from the pay table and when a winning combination is formed depending on a combination of the symbols statically display on the display unit (*ie: symbols from the different selectable games*), awards a prize based on the second pay table (*ie: pay table from different games*) (*see col. 17: ln 20-35*). Additionally, Mastera teaches that the controller switches from the pay table to the second table according to game states (*see col. 17: ln 20-35*). One would be motivated to incorporate the features of Mastera with that of Loose in order to allow for multiple games to be incorporated into a game machine and therefore allow for the different pay schemes to be portrayed to the users that are playing the games on the game machine. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Mastera with that of Loose a the time the invention was made.

Regarding claim 2, Loose et al. teaches a gaming machine comprising a translucent electrical display provided in front of the variable display unit (*see transmissive display [16] of Fig. 2a and the related description thereof*).

Regarding claim 3, Loose et al. teaches a game controller for generating a special game state which gives an advantage to a player a player based on a predetermined condition (*see bonus game of Fig. 7 and the related description thereof*); wherein the translucent electrical display executes shielding control for making at least part of the variable display unit invisible to

the player during the special game state, based on a prescribed condition (*see Fig. 8a and the related description thereof*).

Regarding claim 6, Loose et al. teaches a game machine wherein the electrical display displays an image for decorating the gaming machine (*see Fig. 8c and the related description thereof*).

Regarding claim 7, Loose et al. teaches a game machine wherein the translucent electrical display displays an image according to a game state while executing the shielding control (*see Figs. 10(b-c) and the related description thereof*).

Regarding claim 8, Loose teaches a game machine wherein the translucent electrical display executes the shielding control to indicate an advantageous way of operating the gaming machine to the player (*ie: Wild symbol occurring for advantageous result for player*) (*see Fig. 9c and the related description thereof*).

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. and Mastera et al. as applied to claims above, and further in view of Luccesi et al. (US 6,793,578 B2).

Regarding claims 9-10, Loose et al. teaches a gaming machine comprising: a display unit configured to variably and statically display a plurality of symbols (*see mechanical reels [12(a-c)] of Fig. 1 and the related description thereof*); an electrical display provided in front of the display unit and configured to display a pay table in which a winning combination is associated with a predetermined prize to be awarded when the winning combination is formed and a controller configured to (*see Fig. 2(a-b and 5 and the respective related descriptions thereof)*, when the winning combination is formed depending on a combination of the symbols statically

displayed on the display unit, award a prize associated with the formed winning combination based on the pay table (*see microcontroller [30] of Fig. 1 and the related description thereof*). However, Loose does teach the implementation of an electrical display above the mechanical reels as a secondary display but does not teach the display of a paytable on the secondary display *(see display [40] of Fig. 1 and the related description thereof)*.

However in an analogous gaming patent, Mastera et al. teaches the implementation of a secondary display provided on the top of the variable display that displays the pay table (*see secondary display [219] of Fig. 2 and the related description thereof*). Mastera teaches that one would be motivated to incorporate such a feature to allow the player to simultaneously examine the pay table while viewing the primary game (*see col. 17: ln 20-35*). Additionally, Mastera teaches that the display is adaptable to display the pay table of various primary games to allow users to more easily play the various games of slots, keno, or video poker, on a multi-game machine (*see col. 17: ln 20-35*). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the secondary display features of Mastera with that of Loose to incorporate a secondary display that was able to display various paytables dependent on the primary game being played by the user.

Furthermore, Mastera et al. teaches of a gaming machine wherein the controller switches from displaying the pay table on the electrical display to a second pay table different from the pay table and when a winning combination is formed depending on a combination of the symbols statically display on the display unit (*ie: symbols from the different selectable games*), awards a prize based on the second pay table (*ie: pay table from different games*) (*see col. 17: ln 20-35*). Additionally, Mastera teaches that the controller switches from the pay table to the

second table according to game states (*see col. 17: ln 20-35*). One would be motivated to incorporate the features of Mastera with that of Loose in order to allow for multiple games to be incorporated into a game machine and therefore allow for the different pay schemes to be portrayed to the users that are playing the games on the game machine. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Mastera with that of Loose a the time the invention was made. However, Loose and Mastera are silent with respect to teaching a controller that switches from the pay table to the second pay table by changing the predetermined prize associated with the winning combination and the controller changing the winning probabilities of the winning combination.

In a related gaming patent, Luccesi et al. teaches of a primary game with a pay table (*see paytable [124] of Fig. 6(a-b) and the related description thereof*). Additionally, Luccessi teaches of a bonus game that switches the pay table to a second pay table by changing the predetermined prize associated with the winning combination so the game can effectively operate on a pay table that will double the first paytable or simply add 50 credits to the winnings (*ie: multiplier [134] of Fig. 7b and the related description thereof*). Furthermore, the controller changes the winning probabilities of the winning combination because the players odds of winning a prize in the second pay table or bonus game is effectively the probability of a winning occurrence in the primary game multiplied with the probability of the winning in the bonus game. One would be motivated to incorporate the features taught in Luccesi to the game machines taught in Loose and Mastera because bonus games are known to increase a player's appeal to a game. Therefore it would have been obvious to one of ordinary skill in the art at the

time the invention was made to incorporate the features of Luccesi with that of Loose and Mastera at the time the invention was made.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mothwurf et al. (US 6,712,695 B2) – Jackpot System.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH
June 29, 2007

/John M Hotaling II/
John M Hotaling II

Primary examiner 3714